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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/015,630 | 12/17/2001 | Francesco Casuscelli | 217471US0 | 7565 |

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EXAMINER

EPPERSON, JON D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,630

Applicant(s)

CASUSCELLI ET AL.

Examiner

Jon D. Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17 and 26 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/17/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. The Response filed December 22, 2005 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. Please note that any previous indication of allowability is hereby withdrawn in view Applicants' newly cited IDS.

Status of the Claims

4. Claims 1-27 were pending. Applicants amended claims 12-17 and 26. In addition Applicants canceled claims 1-11, 21-25 and 27. No claims were added. Therefore, claims 12-20 and 26 are examined on the merits.

Withdrawn Objections/Rejections

5. All previous rejections and/or objections are withdrawn in view of Applicants' arguments and/or amendments.

New Rejections

Claims Rejections - 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

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basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-17 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamed et al. (Hamed, A. A.; Madkour, H. M. F.; Nuaimi, I. S. A.; Hussain, B. A. "Reactions with 2-methylchromones" *Anales de Quimica* 1994, 90(5-6), 359-64) (10/17/05 IDS).

For *claims 12-17 and 26*, Hamed et al. (see entire document) disclose 3-(2-hydroxyl-5-methylphenyl)-5-methyl-pyrazole-1-carboxamide (e.g., see Hamed et al., abstract; see also Table I, compound XIVc), which anticipates the claimed invention. For example, compound XIVc anticipates the claimed invention wherein R₇ is C(=O)NH₂, R₅ is hydrogen, R₆ is methyl (i.e., C₁-C₆ alkyl), R₁, R₂ and R₄ are hydrogen and R₃ is methyl (i.e., C₁-C₆ alkyl). The Examiner notes that Applicants' proviso language in claim 12 (e.g., "when R₇ is CONH₂ ... and R₅ is H the R₆ is not H, CH₃ or phenyl group") is not implicated here as Applicants have only excluded a phenyl group, not a "substituted" phenyl group (e.g., compare this proviso with the next proviso that explicitly excludes "optionally substituted" phenyl groups). For claim 26, it is noted that a preamble is generally not accorded any patentable weight where it merely recited the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150-, 152, 88 USPQ 478, 481 (CCPA 1951). Here,

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the “use as a medicament” statement occurs in the preamble and merely recites “the intended use of a structure” and thus is not afforded any patentable weight in accordance with cases like *In re Hirao* and *Kropa v. Robie*.

Allowable Subject Matter

7. Claim 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 10/17/05 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Jon D. Epperson, Ph.D.
January 11, 2006



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